

REMARKS

In response to the Office Action dated September 29, 2005, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 12-13 have been amended, and new Claims 14-15 have been added, leaving Claims 1-15 for consideration upon the entry of the amendments. Examples 1-3 of the specification on page 8, lines 22-33 of the specification discuss the features of Claims 12-15. No new matter has been added by the amendments.

Claim Objections

Claim 13 is objected to because of grammar error. Claim 13 has been amended to correct the error.

Claim Rejections under 35 U.S.C. 112

Claim 12 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The percentage, in Claim 12, has been amended to recite mol%.

Claim Rejections under 35 U.S.C. 102

Claims 1-12 stand rejected under 35 U.S.C. 102(b) as being anticipated by Senda, U.S. Patent No. 4,433,029 (hereinafter "Senda"). Applicant respectfully traverses the rejections.

To anticipate a claim under 35 U.S.C. ' 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Senda however, fails to disclose all of the elements of Claim 1.

Claim 1 recites an expanded polystyrene particle with a functional skin layer comprising: an inner expanded polystyrene layer; and a functional skin layer, wherein the inner expanded polystyrene layer is formed by heating and expanding an expandable polystyrene bead or pellet, and the functional skin layer is formed by coating the surface

of the inner expanded polystyrene layer with a functional coating composition having 10 to 99 wt% of a vinyl acetate based polymer and 0.1 to 90 wt% of at least one functional additive.

In contrast, the abstract of Senda teaches that expandable thermoplastic polymer beads and method of producing same, wherein a core of a polymer of one or more vinyl monomers is substantially surrounded by a layer of a polyolefin comprising one or more vinyl monomers, with a foaming agent contained in at least the core. Senda however, is silent in the expanded polystyrene particle having the inner expanded polystyrene layer formed by heating and expanding an expandable polystyrene bead or pellet.

The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) The disclosure in Senda however, does not provide an enabling disclosure of the skin layer as recited in Claim 1.

The expanded polystyrene contains 98 vol% of air and only about 2vol % of the polymer resin (See page 1, lines 35-36 of the specification). Therefore, the expanded polystyrene forms a form structure. Col. 3, lines 11-20 of Senda simply teach that this invention, ..., comprises suspending grains of a vinyl polymer, a powdered polyolefine, one or more vinyl monomers and a cross-linking agent in an aqueous medium containing a dispersing agent, and polymerizing the vinyl monomers in the presence of an initiator, ..., starting the polymerization. Senda however, does not provide how to form the skin layer at the surface of the form structure by polymerizing the vinyl monomer.

Thus, Senda neither anticipates nor renders Claim 1 obvious because it fails to disclose the elements “an inner expanded polystyrene layer; and a functional skin layer, wherein the inner expanded polystyrene layer is formed by heating and expanding an expandable polystyrene bead or pellet, and the functional skin layer is formed by coating the surface of the inner expanded polystyrene layer with a functional coating composition having 10 to 99 wt% of a vinyl acetate based polymer and 0.1 to 90 wt% of at least one functional additive”, as recited in Claim 1. Also, Senda fails to provide the enabling

disclose of the elements. Claims 2-5 and 11-13, and new Claims 14-15 depend from Claim 1. These dependent claims are believed to be allowable due to their dependency.

Since it contains similar features, Claim 6 is patentable over Senda for at least the reasons given for Claim 1. Claims 7-10 depend from Claim 6, and thus are believed to be allowable due to their dependency.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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